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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

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DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/922,089

Applicant(s)

PELLEY ET AL.

Examiner

Patricia L. Hailey

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Claim Objections*

1. Claim 7 is objected to because of the following informalities:

It appears that the phrase "which has of flow viscosity" in claim 7 should be "which has a flow viscosity" (emphasis added).

Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Eden et al. (U.S. Patent No. 5,688,845), Applicants' submitted art.

Eden et al. teach an adhesive consisting essentially of at least about 50% to less than 100% of a maltodextrin syrup, 0 to about 50% water, and a preservative. The maltodextrin is prepared from a converted or non-converted chemically derivatized starch. See col. 4, lines 23-41 of Eden et al.

The starch can be derivatized by either heat- and/or acid conversion, oxidation, phosphorylation, etherification, esterification, etc. Further, the starch is preferably derivatized before subjected to enzyme conversion. See col. 7, lines 38-49 of Eden et al.

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The adhesive may also contain additional ingredients such as salts (to cause hygroscopic blocking) and humectants (to reduce the adhesive's initial viscosity). See col. 7, lines 5-18 of Eden et al., as well as col. 9, lines 12-20.

The property of flow viscosity is considered to be inherently read upon by the teaching of Eden et al., as this reference reads upon the claim limitations in their present form.

In view of these teachings, Eden et al. anticipate claims 1, 2, and 9-11.

4. Claims 1-7 and 10-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Lydzinski et al. (U. S. Patent No. 6,280,515).

Lydzinski et al. teach a foamable adhesive comprising a polysaccharide modified with an alkyl succinic anhydride and water. See col. 2, lines 21-26 and lines 54-65 of Lydzinski et al.

Examples of the polysaccharide which can be modified include starches, either native, converted or derivatized. See col. 2, lines 27 <sup>62</sup> ~~to 53~~ of Lydzinski et al.

The adhesive may also contain additives such as humectants (such as calcium chloride and corn syrup) and synthetic resins. See col. 3, lines 1-20 of Lydzinski et al.

The adhesive of Lydzinski et al. is useful in applications such as paper laminating, surface coatings, and other adhesive applications. See col. 3, lines 33-39 of Lydzinski et al. This disclosure is considered to read upon the limitations of claims 12-15.

The property of flow viscosity is considered to be inherently read upon by the teaching of Lydzinski et al., as this reference reads upon the claim limitations in their present form.

In view of these teachings, Lydzinski et al. anticipate claims 1-7 and 10-15.

*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eden et al. (U. S. Patent No. 5,688,845).

Eden et al. is relied upon for its teachings in the above 102(b) rejection. While this reference teaches at col. 7, lines 38-45 that the starch is preferably chemically derivatized prior to enzyme conversion (i.e., heat- and/or acid conversion, oxidation, etc.), one of ordinary skill in the art would expect that these two steps are interchangeable, i.e., that the starch can be enzymatically converted prior to being derivatized, as Eden et al. do not require that these two steps be performed in any specific order.

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Reversing the order of steps in a process does not impart patentability when no unexpected result is obtained. Ex parte Rubin (POBA 1959) 128 U.S.P.Q. 440, Cohn v. Comr. Pats. (DCDC 1966) 251 F Supp 378, 148 U.S.P.Q. 486.


*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (703) 308-3317. The examiner can normally be reached on Mondays-Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

  
Lynn Hailey/plh  
Examiner, Art Unit 1755  
March 18, 2003

  
Mark L. Bell  
Supervisory Patent Examiner  
Technology Center 1700